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ACACIA MEDIA TECHNOLOGIES CORPORATION

UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

SAN JOSE DIVISION

In re ACACIA MEDIA TECHNOLOGIES CORPORATION,	Case No.05 CV 01114 JW **PROPOSED SEQUENCE OF ISSUES TO ADDRESS DURING ORAL ARGUMENT OF PENDING SUMMARY JUDGMENT MOTIONS** DATE: TBD TIME: TBD CTRM: 8, 4th Floor JUDGE: Hon. James Ware

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TO ALL PARTIES AND TO THE COURT:

The voluminous contents of the now fully briefed summary judgment motions command an efficient sequence for oral argument to potentially resolve all of the pending summary judgment motions in a single hearing. All of the Defendants state in their responses, and Plaintiffs agree, that the resolution of relatively few, foundational disagreements concerning the applicable law of written description and enablement will largely be determinative of the pending motions. Accordingly, Plaintiff proposes that the Court at the first available hearing date consider the following issues which, depending upon the Court's rulings, may completely dispose of all pending motions and obviate the need for any further hearings on the pending summary judgment motions:

POTENTIALLY DISPOSITIVE ISSUES RELATING TO THE WRITTEN DESCRIPTION AND ENABLEMENT REQUIREMENTS OF 35 U.S.C. § 112

Issue 1

In an invention pertaining to the electrical and computer arts, can the written description requirement of 35 U.S.C. § 112—whether expressed as a determination of whether the inventor disclosed in the patent specification to those skilled in the art that the inventor was in possession of the invention or whether the inventor described in the specification the "detailed identity" of the invention to one of ordinary skill in the art—be met where certain components of the invention are not publicly available as "off the shelf" items, but those same components are described in the patent specification in terms of their inputs, functions and outputs such that a person of ordinary skill in the art would be able to understand and implement the structure of those components via routine design choices?

Issue 2

Can the Court determine on the face of the Yurt patents alone that no material dispute of fact exists as to whether the asserted claims are invalid by clear and convincing evidence for failure to meet either the written description requirement or the enablement requirement, despite unopposed expert testimony of record asserting that one of skill in the art, from reading the original disclosure of the Yurt patents and applying the knowledge known to one skilled in the art of the Yurt patents,

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would understand that the inventors were in possession of the claimed system at the time the patent application was filed and would further understand how to make and use the electronic and software structures of the claimed system through routine design and without undue experimentation?

Issue 3

Where the Court has already found that all the asserted claims are indefinite under 35 U.S.C. § 112, and therefore insolubly ambiguous and not amenable to a definite construction, how can the Court understand the claimed invention in order to determine if that invention was described in the patent specification or would require undue experimentation in order for one of ordinary skill in the art to practice it?

REMAINING ISSUES RELATING TO INDEFINITENESS

Issue 4

Whether Claims 17-19 of the '863 patent are indefinite with respect to the inclusion of the phrase "to at a plurality of receiving stations"? (See, Round 3 Defendants' Motion for Summary Judgment, at V.D., 54:24-57:3).

Issue 5

Whether Claim 41 of the '992 patent is indefinite with respect to the phrase "storing items having information in a source material library"? (See, Round 3 Defendants' Motion for Summary Judgment, at 57:9-16).

Issue 6

Whether Claim 45 of the '992 patent is indefinite with respect to the phrase "separately storing a plurality of files"? (See, Round 3 Defendants' Motion for Summary Judgment, at 57:17-58:2).

Issue 7

Whether Claim 46 of the '992 patent is indefinite with respect to retrieving data blocks corresponding to requests from users? (See, Round 3 Defendants' Motion for Summary Judgment, at 58:3-11).

Issue 8

Whether Claims 17-19 of the ’992 patent are indefinite with respect to the “local distribution system”? (See, Round 3, Motion for Summary Judgment, at 50:5-7).

UNOPPOSED ISSUES FOR WHICH SUMMARY JUDGMENT SHOULD BE GRANTED IN FAVOR OF DEFENDANTS

Grant the Defendants’ unopposed Motion for Summary Judgment that each asserted claim is indefinite based on: (1) the Court’s determinations that the terms “sequence encoder” and “identification encoder” are indefinite, (2) the Court’s determination that the term “transmission system” must include an “identification encoder,” and (3) the Court’s determination that the term “central processing location” includes a “transmission system.” (See, Round 3 Defendants’ Motion for Summary Judgment, at V.B. and V.C, 54:1-23 in which all Defendants join).

Respectfully submitted,

DATED: April 16, 2009

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